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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/202,054 12/07/98 GODDARD

A P1154R2

EXAMINER

HM12/0607

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1 DNA WAY  
SOUTH SAN FRANCISCO CA 94080-4990

TLING, M

ART UNIT

PAPER NUMBER

1644

DATE MAILED:

06/07/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

# Office Action Summary

Application No.  
09/202,054

Applicant(s)  
Goddard, et al.

Examiner  
Mary B. Tung

Art Unit  
1644



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Apr 6, 2001
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-40 are subject to restriction and/or election requirements.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 20) ☐ Other: \_\_\_\_\_

***DETAILED ACTION***

***Election/Restriction***

**Please Note:** In an effort to enhance communication with our customers and reduce processing time, Group 1640 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is 703-305-3704. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot Program. If you have any questions or suggestions, please contact Paula Hutzell, Supervisory Patent Examiner at paula.hutzell@uspto.gov or 703-308-4310. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

1. Restriction to one of the following inventions is required under 35 U.S.C. § 121:
  - I. Claims 1, 2, 5-11, 15, 16, and 18-24, are drawn to an isolated nucleic acid, encoding a PRO285 or PRO286 polypeptide, a vector, a host cell, process for producing said polypeptide, classified in class 536, subclass 23.5 and class 435, subclasses 69.1, 320.1 and 252.33.
  - II. Claims 1-4, 12-14, and 17-24 are drawn to an isolated nucleic acid, derived from human bone marrow, encoding a PRO385 polypeptide, a vector, a host cell, a process for producing said polypeptide, classified in class 536, subclass 23.5, class 435, subclasses 69.1, 320.1, and 252.33.
  - III. Claims 25-30 and 38, drawn to a chimeric antibody comprising PRO285 or PRO286, classified in class 530, subclass 387.3.
  - IV. Claims 25-30 and 38, drawn to a chimeric antibody comprising PRO385, classified in class 530, subclass 387.3.
  - V. Claims 31-33 and 38, drawn to an anti-TLR2 receptor antibody, classified in class 530, subclass 388.22.
  - VI. Claims 34-36, drawn to a human TLR2 variant, classified in class 530, subclass 350.
  - VII. Claim 37, drawn to a method for treatment using antibody to peptide encoded by DNA42663 or DNA40021, classified in class 424, subclass 139.1.
  - VIII. Claim 37, drawn to a method for treatment using antibody to peptide encoded by DNA47361, classified in class 424, subclass 139.1.
  - IX. Claim 37, drawn to a method for treatment using antibody to human TLR2, classified in class 424, subclass 143.1.
  - X. Claim 39, drawn to an agonist of PRO285 or PRO286, classified in class 514, subclass 2.
  - XI. Claim 39, drawn to an agonist of PRO358, classified in class 514, subclass 2.
  - XII. Claim 40, drawn to an antagonist of PRO285 or PRO286, classified in class 514, subclass 2.

XIII. Claim 40, drawn to an antagonist of PRO358, classified in class 514, subclass 2.

2. The inventions are distinct, each from the other because of the following reasons:
3. Groups I-VI and X-XIII are unique products. They differ with respect to their physicochemical properties and are therefore patentably distinct. The PRO285 and PRO286 peptides are distinct from PRO358 based on their differing sources, sequences and expected properties.
4. Groups VII-IX are unique methods. They differ with respect to ingredients and method steps. A method for treatment using an antibody to the polypeptide encoded by the various deposited vectors and to a human Toll-like receptor represent patentably distinct subject matter.
5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, and because a search of any or these three distinct inventions would not be co-extensive with a search of the others, an examination and search of two or more inventions in a single application would constitute a serious undue burden on the Examiner, restriction for examination purposes as indicated is proper.

**Note:** The invention of claims 1, 2, 25-30, 37-40 will be examined along with their respective elected Group.

### *Conclusion*

6. Papers related to this application may be submitted to Group 1640 by facsimile transmission. Papers should be faxed to Group 1640 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). THE CM1 FAX CENTER TELEPHONE NUMBER IS (703) 305-3014 or (703) 308-4242.
7. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Mary Tung whose telephone number is (703)308-9344. The Examiner can normally be reached Tuesday through Friday from 8:30 am to 6:00 pm. A message may be left on the Examiner's voice mail service. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Christina Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1640 receptionist whose telephone number is (703) 308-0196.

Serial No. 09/202,054  
Art Unit 1644

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June 6, 2001  
Mary B. Tung, Ph.D.  
Patent Examiner  
Group 1640

*Mary B. Tung*  
MARY BETH TUNG, PH.D.  
PATENT EXAMINER